

REMARKS

Priority Claim.

The Examiner stated that the information in Applicants' priority claim set forth in the first sentence of the specification is not in agreement with the Applicants' information data sheet as required and requested correction. Applicants note that the claims have been amended from those claims originally filed with the first preliminary amendment. Accordingly, Applicants have amended the specification to specify that the present application claims priority to and benefit of only U.S. Patent Application Serial No. 08/769,062, filed December 18, 1996, which is now U.S. Patent No. 6,335,160.

Specifically, the first page of the specification has been amended as follows:

This application is a continuation of U.S. Patent Application Serial No. 08/769,062, filed December 18, 1996, now U.S. Patent No. 6,335,160, the specification of which is herein incorporated by reference in its entirety for all purposes.

Applicants respectfully request entry of this Amendment.

Objection to the Drawings.

Figures 2A-2G were objected to because the Examiner believes they are not in compliance with 37 CFR 1.821 because SEQ ID NOS for the nucleotide sequences are missing. Applicants respectfully traverse this objection and note that the formal drawings previously filed as Figures 2A-2G do include the proper SEQ ID NOS (SEQ ID NOS:78-98) for each of the nucleotide sequences, as shown on the pages labeled Figure 2B and Figure 2G. The SEQ ID NOS are placed at the end of each nucleotide sequence. Withdrawal of the objection is respectfully requested.

Status of Information Disclosure Statements/Substitute PTO Form 1449s.

Applicants thank the Examiner for her review of most of the previously submitted Information Disclosure Statements/Substitute PTO Form 1449s. However, it is not clear whether the Examiner has not yet considered all of the previously submitted Information Disclosure Statements/Substitute PTO Form 1449s. Applicants note that included with the Office Action mailed on July 1, 2003 were three previously submitted Substitute PTO Form 1449s (the first comprising 2 pages, the second comprising 5 pages, and the third comprising 1 page) that were not

signed or dated by the Examiner. Thus, it is not clear whether the Examiner specifically considered the references cited on these Substitute PTO Form 1449s.

Applicants respectfully request that the Examiner expressly consider these references and initial and date each reference where indicated on the Substitute PTO Form 1449s. For the convenience of the Examiner, Applicants attach hereto the three previously submitted Information Disclosure Statements/Substitute PTO Form 1449s that have not yet been signed and dated by the Examiner.

Status of the Claims.

Claims 278-296 are currently pending. Claim 278 has been amended as suggested by the Examiner and as discussed in detail below. This amendment introduces no new matter and is fully supported by the specification as filed.

Rejections Under 35 USC § 112.

Claims 278-292, 295, and 296 were rejected under 35 USC § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. In particular, the Examiner finds that claims 278-289 are confusing due to incorrect syntax in the last line of (d) because the grammatical object (or antecedent) of "that is derivatized" is unclear. The Examiner suggests that the word "that be replaced with --which polypeptide. Office Action, p. 2. The Examiner further found that such amendment to claim 278 would render claims 278 and 295 confusing due to their duplicity such that one of the claims would need to be canceled. This rejection has been overcome in part and is traversed in part.

First, Applicants thank the Examiner for her careful reading of the claims and helpful suggestion. Applicants have amended claim 278 as suggested by the Examiner.

Second, Applicants respectfully traverse the finding that claim 278, as now amended, and claim 295 are duplicative. As amended, claim 278 provides in (d):

(d) screening or selecting from the derivatized polypeptide expression products of (c) to identify at least one evolved polypeptide having an *altered immunogenicity or stability relative to the polypeptide encoded by the DNA substrate molecule which polypeptide is derivatized with the moiety.*

Claim 295 provides in (d):

(d) screening or selecting from the derivatized polypeptide expression products of (c) to identify at least one evolved polypeptide having an ***altered affinity for a receptor or a ligand*** relative to the polypeptide encoded by the DNA substrate molecule which polypeptide is derivatized with the moiety.

Applicants submit that claims 278 and 295 are not duplicative, because the screening or selecting steps of claim 278 differs from the screening or selecting step of claim 295. Specifically, claim 278 provides for screening or selecting at least one evolved polypeptide having an ***altered immunogenicity or stability*** relative to the polypeptide encoded by the DNA substrate molecule which polypeptide is derivatized with the moiety. Claim 295 provides for screening or selecting at least one evolved polypeptide having an ***altered affinity for a receptor or a ligand*** relative to the polypeptide encoded by the DNA substrate molecule which polypeptide is derivatized with the moiety. Because the claims are not duplicative, one need not be canceled.

For at least these reasons, Applicants respectfully request that the rejection be withdrawn.

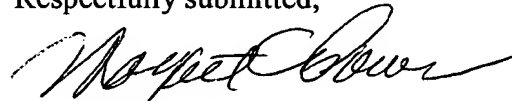
Rejection Under Doctrine of Obviousness-Type Double Patenting.

Claims 278-296 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,455,253. This rejection has been overcome by the enclosed Terminal Disclaimer, which disclaims the terminal part of the statutory term of any patent granted on the instant application that would extend beyond the expiration date of the full statutory term of U.S. Patent No. 6,455,253. Withdrawal of the rejection is respectfully requested.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. If a telephone conference would expedite prosecution of this application in any way, the Examiner is invited to telephone the undersigned at (650) 298-5809.

Respectfully submitted,



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November 3, 2003
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